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Paper No. 11

BLANK ROME COMISKY & MCCAULEY, LLP
900 17TH STREET, N.W., SUITE 1000
WASHINGTON, DC 20006

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In re Application of	:	OFFICE OF PETITIONS
McGraw et al.	:	
Application No. 09/556,389	:	ON PETITION
Filed: April 24, 2000	:	
Attorney Docket No. 000309.00011	:	

This is a decision on the petition under 37 CFR 1.181, filed December 11, 2001, and supplemented June 4, 2002, requesting refund of a filing fee, a notice of appeal fee, and extension of time fees.

The petition is **DISMISSED**. The Office does not have the authority to grant the relief requested.

Analysis:

35 USC 41(a) states, "The Director shall charge the following fees."

35 USC 41(a)(1)(A) states, "On filing each application for an original patent, except in design or plant cases, \$690."

35 USC 41(a)(6)(A) states, "On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$300."

35 USC 41(a)(8) states, "For petitions for 1-month extensions of time to take actions required by the Director in an application-

- (A) on filing a first petition, \$110;
- (B) on filing a second petition, \$270; and
- (C) on filing a third or subsequent petition, \$490."

The use of the word "shall" in 35 USC 41 requires the Office to charge the fees.¹ Once the fees have been "charge[d]," the Office does not have the authority to refund the fee except under 35 USC 42 which permits refund of "any fee paid by mistake or any amount paid in excess of that required."

¹ It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. *Farrel Corp. v. U.S. Int'l Trade Comm'n*, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). The court in *Boyden v. Comm'r of Patents*, 441 F.2d 1041, fn 3, (D.C. Cir. 1971) states, "'Shall' is the language of command, *Escoe v. Zerbst*, 295 U.S. 490, 493, 55 S. Ct. 818, 79 L. Ed. 1566 (1935) as Mr. Justice Cardozo observed for a unanimous court. And see the discussion by Mr. Justice Stone in *Richbourg Motor Co. v. United States*, 281 U.S. 528, 534, 50 S. Ct. 385, 74 L. Ed. 1016 (1930)."

The court in BEC Pressure Controls Corp. v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (N.D. Ind. 1974), states,

Although it does not deal specifically with § 151, a more recent case involving the payment of fees to the Patent Office which reinforces the idea of strict compliance with the governing statute expressed in Brenner, *supra*, is Boyden v. Commissioner of Patents, 142 U.S.App.D.C. 351, 441 F.2d 1041 (1971). There the court said that it is mandatory that the Commissioner of Patents charge and that the applicant pay the fees specified by statute as a prerequisite to the filing of a patent application. More importantly, however, the court noted that the duty of the Commissioner in this regard stems from a clear statutory requirement. Therefore, there is no grant of discretionary power to him, and he has no authority to waive the prescribed payment. Furthermore, the court makes it clear that the federal court is not authorized to order the Commissioner to waive the payment of such filing fees.

For the above reasons, since the fees were "charged" to petitioner's deposit account prior to the filing of the petitions, petitioner must satisfy 35 USC 42(d). Petitioner fails to satisfy 35 USC 42(d) in so far as petitioner has failed to prove that the fees were "paid by mistake." Petitioner intended to file each of the fees and to submit the notice of appeal, the requests for extension of time, and CPA. The fees were not paid by mistake.

MPEP 607.02 states,

When an applicant or patentee takes an action "by mistake" (e.g. files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g. a filing fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 41 (d).

Petitioner desired a notice of appeal, extension of time, and CPA when he filed the deposited papers, and petitioner received what he paid for. As such, there was no error in relation to the payment of fees to the PTO. In other words, petitioner has filed to show that the asserted mistake when filing the instant papers was a mistake in relation to payment of the fees owed, by law, at the time the papers were filed. The mistake made by petitioner is not a mistake as contemplated by 35 USC 42(d).²

Since the petition is being treated as a petition under 37 CFR 1.181, rather than 1.182, the petition fee will be credited to petitioner's deposit account.

The file is now being forwarded to Technology Center 3700.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.


Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

² See Miessner v. U.S., 228 F.2d 643 (D.C. Cir. 1955).